



IN THE UNITED STATES PATENT OFFICE

Applicant : Biggadike et al.
Application No. : 10/066,836
Filed : February 4, 2002
Title : Novel Anti-inflammatory Androstane
Derivative

Grp./A.U. : 1616
Examiner : Badio, Barbara

Docket No. : PG4739

Commissioner of Patents
Washington DC 20231

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RESPONSE TO OFFICIAL ACTION OF SEPTEMBER 26, 2003

The following is in response to the Official Action of September 26, 2003.

Applicant has considered the basis of the examiner's provisional rejection of claims under the judicially created doctrine of obviousness-type double patenting over the mentioned claims of US 10/067,020, 10/066,964, 10/200,364, and 10/241,658.

Rather than belabor the grounds why the applicants feel that the Examiner's position is incorrect and the claims of the present application are non-obvious over the claims of the co-pending cases, applicant has attached terminal disclaimers over the co-pending applications of record. These terminal disclaimers are filed in without prejudice to applicant's right to argue the issue of double-patenting and obviousness in the future, and are provided solely in an effort to promote allowance of the case.

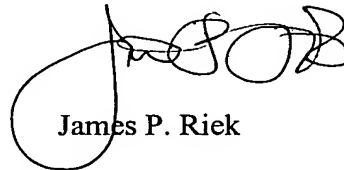
Applicant points out that the included terminal disclaimers have no effect on the actual term of any patent resulting from this application, as the patents resulting from each of the disclaimed cases would have expired on the same date as a patent issuing from this application, even in the absence of the disclaimer. In filing these disclaimers, applicant specifically reserves the right to address any double patenting issues in the future, whether or not mentioned in this Response, should the need arise.

Applicant makes particular note of MPEP 804.02 II and established case law findings of the Federal Circuit, in Quad Environmental Technologies v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991), that the filing of a terminal disclaimer to obviate a rejection based on a non-statutory double patenting is not an admission of the propriety of the rejection. The filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.

In light of the terminal disclaimers filed herewith, all issued raised by the examiner in the Official Action have been addressed. As such, the claims are asserted to be in a condition for allowance. Applicant requests that a timely Notice of Allowance be issued in this case. If any matters exist that preclude issuance of a Notice of Allowance, the examiner is requested to contact the applicant's representative at the number indicated below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge any fees or credit any overpayment, particularly including any fees required under 37 CFR Sections 1.16 and/or 1.17, and any necessary extension of time fees, to deposit Account No. 07-1392.

Respectfully submitted,



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Dated: 28 Oct 03

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